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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,331	05/10/2002	Klaus Bartsch	514413-3899	7900
20999	7590	02/26/2004		
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151				
EXAMINER LILLING, HERBERT J				
ART UNIT		PAPER NUMBER		
1651				

DATE MAILED: 02/26/2004

DOCKETED

Please find below and/or attached an Office communication concerning this application or proceeding.

2004 FEB 28 PM 12:08
FROMMER, LAWRENCE
& HAUG, LLP



Office Action Summary

Application No.	Applicant(s)	
10/018,331	BARTSCH	
Examiner	Art Unit	
HERBERT J LILLING	1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 14-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Receipt is acknowledged of the preliminary amendment filed October 26, 2001.
2. Claims 14-26 are now pending in this application.
Claims 1-13 have been cancelled.
3. Restriction to one of the following inventions is required under 35

U.S.C. 121:

- II.
4. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- I. Claims 14-22, drawn to a process for preparing L-PPT of formula I, by the reaction of HMPB, PPO in the presence of aspartate transaminases, classified in class 435, subclass 106.

Claim 23-26, drawn to microorganisms, classified in class 435, subclass unknown due to lack of suitable description

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Group I does not require the specifics of Group II.

In accordance with PCT rules, Applicant has not demonstrated the same technical special feature for each of the above inventions. Restriction is proper.

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According to the specification, the specific stable transaminases were derived by the use of specific microorganisms, which have not been described in detail. The specification may be fatally defective as presently submitted to employ the best mode to obtain the most desired results. Applicant has failed to describe in detail the missing information. If Applicant elects Invention I, Applicant is required to submit evidence as to structure of the aminotransferases that have been employed in the specification or a product by process for obtaining the aminotransferases. If they were obtained from a non-available strain which is not available to the public, Applicant will have a problem in obtaining a patent until that strain is available to the public. If Applicant elects Invention II, there are two obstacles which this instant specification lacks, (a) a complete description of the morphological, physical and chemical properties of the claimed microorganisms in order to perform search and examination of the claimed species and (b) a deposit of the microorganisms in accordance with the U.S. Rules of Deposits which includes a statement as to the availability of the strain(s) without any restrictions to the public.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Examiner Lilling whose telephone number is 571-272-0918 and Fax Number is for applications Before Final (703) 872-9306 and After Final for applications is 703-872-9307 or SPE Michael Wityshyn whose telephone number is 571-272-0926.** Examiner can be reached Monday-Thursday from about 5:30 A.M. to about 3:00 P.M. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

H.J.Lilling: HJL
(703) 308-2034
Art Unit 1651
February 23, 2004



Dr. Herbert J. Lilling
Primary Examiner
Group 1600 Art Unit 1651